<u>REMARKS</u>

Reconsideration of the present application is respectfully requested. No claims
have been amended. Claims 1 – 32 are currently pending.

<u>**Rejections based on 35 U.S.C. § 103**</u>

Claims 1 – 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over
Deleeuw, U.S. Patent No. 5,828,900 ("Deleeuw"). Applicants respectfully traverse this rejection
because the Office Action fails to establish a prima facie case of obviousness and because
Deleeuw actually teaches away from the modification suggested by the Office Action. Further,
even if the Deleeuw reference were modified as suggested by the Office Action, the proposed
modification does not demonstrate that the present invention, taken as a whole, would be obvious
to a skilled artisan.

<u>The Office Action Fails to Establish a Prima Facie Case of Obviousness.</u>

To address various problems in the art surrounding handling an input event,
independent claim 1 recites a novel method that requires "notifying an application of said input
event by providing said application a sentinel value when the text converting component is
interested in performing said conversion action." Similar claim language is found in the other
independent claims, claims 13, 25, and 30.

The Office Action admits that Deleeuw fails to teach notifying an application of
an input event by providing a sentinel value, as required by the various independent claims.
Office Action, pp. 2 – 3. The Office Action states, "Although Deleeuw doesn't explicitly
describe sending a sentinel value to the application, he does describe that the event needs to be
blocked from the application." Office Action, pp. 2 – 3. Relying on this disclosure by Deleeuw,
the Office Action reaches to "one of ordinary skill in the art" to teach the sending of a sentinel

value as a notification to an application, as required by the independent claims. Office Action, p.

3. However, as the Deleeuw reference fails to teach each and every claim limitation, the Office

Action fails to establish a prima facie case of obviousness.

As dictated by the MPEP, to establish a prima facie case of obviousness "the prior

art reference (or references when combined) must teach or suggest all the claim limitations."

MPEP § 2142 (emphasis added). The Office Action, however, admits that the reference fails to

teach "sending a sentinel value to the application." Office Action, p. 2. Instead of using a

sentinel value, Deleeuw teaches disabling the host application from receiving the input events.

Office Action, p. 2. In fact, there is no suggestion by Deleeuw to use a sentinel value for any

purpose. While Deleeuw may recognize the same problem addressed by the Applicants,

Deleeuw fails to "teach or suggest all the claim limitations" recited in the various independent

claims. As such, Applicants respectfully submit that the Office Action fails to establish a prima

facie case of obviousness.

Taken *as a Whole*, the Claimed Invention is Novel Over the Prior Art.

As previously discussed, Deleeuw addresses a similar problem as the present

application but does not suggest the particular solution claimed by the Applicants. Mere

recognition of a problem, of course, does not render a particular solution obvious. Indeed, the

reference is silent with respect to key features of the claimed invention, including notifying an

application of an input event or the use of a sentential value. While the Office Action asserts that

these features were known to those skilled in the art, inventions typically are new combinations

of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed.

Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements.").

Importantly, Section 103 precludes the "hindsight discounting of the value of new combinations

by requiring *assessment of the invention as a whole*." *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270,

1275 (Fed. Cir. 2004)(emphasis added). Without any mention in the prior art of using a

sentential value along with systems such as Deleeuw's, Applicants respectfully submit that the

pending claims combine "various existing features or principles in a new way to achieve a new

result," which is "the very definition of invention." *Ruiz*, 357 F.3d at 1275.

<p align="center">Deleeuw Explicitly Teaches Away From The Suggested Modification.</p>

The solution provided by Deleeuw and the proposed modification are

inconsistent, and Deleeuw teaches away from such a modification. In handling an input event,

Deleeuw expressly requires the **disablement** of an application to prevent any event handling.

Deleeuw, col. 2, ll. 1 – 34; col. 6, ll. 9 - 12. The proposed modification of Deleeuw, however,

requires the application be **notified** of the input event so as to potentially allow processing

responsive to the event. Clearly, disabling the application would destroy any utility associated

with notifying the application of the input. So the proposed modification requires the application

remain **enabled**. By requiring the disablement of the application, Deleeuw explicitly teaches

away from any modifications dictating that the application remaining enabled. "It is improper to

combine references where the references teach away from their combination." *In re Grasselli*,

713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Deleeuw's disablement of the

application explicitly teaches away from the proposed modification set forth by the Office

Action, and, thus, the proposed modification would not be obvious in light of Deleeuw's

teachings.

<p align="center">The Pending Claims are Allowable Over the Prior Art.</p>

Applicants respectfully submit that claims 1 - 32 are allowable because they

combine "various existing features or principles in a new way to achieve a new result." The

proposed modification of Deleeuw is inappropriate under the relevant law, and the Office Action

fails to establish a prima facie case of obviousness. Indeed, Deleeuw does not teach or suggest

"notifying an application of said input event by providing said application a sentinel value when

the text converting component is interested in performing said conversion action," as required by

independent claim 1. Similarly, Deleeuw does not teach or suggest preventing "an application

from handling said user input event by providing a sentinel value to said application when one or

more of said text converting components are interested in performing a conversion action," as

required by independent claims 13, 25, and 30. Thus, Applicants respectfully submit

independent claims 1, 13, 25 and 30 are in condition for allowance.

Applicants further submit that dependent claims 2- 12, which depend from claim

1, are in condition for allowance for at least the same reasons discussed above with respect to

claim 1. Applicants further submit that dependent claims 14 - 24, which depend from claim 13,

are in condition for allowance for at least the same reasons discussed above with respect to claim

13. Applicants further submit that dependent claims 26 - 29, which depend from claim 25, are in

condition for allowance for at least the same reasons discussed above with respect to claim 25.

Applicants further submit that dependent claims 31 and 32, which depend from claim 30, are in

condition for allowance for at least the same reasons discussed above with respect to claim 30.

Conclusion

For the reasons stated above, Claims 1 – 32 are in condition for allowance. If any issues remain which would prevent issuance of this application, the Examiner is urged to contact the undersigned prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,

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